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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,648	05/22/2001	Roger Woodruff	1370.018US1	8678

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EXAMINER

LIM, KRISNA

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,648

Applicant(s)

WOODRUFF, ROGER

Examiner

Krisna Lim

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-31 are still pending for examination.

2. Claims 1-3, 7, 10, 14, 18, 22 and 26-27 are still rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 26, it is unclear how a device is discovered. It is unclear from where and to where the encoded name is transmitted across a network.

In claims 2 and 27, it is unclear where the encoded name is received. It is unclear from where the name is sent to a host.

In claim 3, the interconnection among the device, the host and the server is not understood.

In claim 7, it is similar to claims 1-3 above. Moreover, it is unclear how those adapters are connected in the server.

In claim 10, it contains similar problem as in claims 1-3 above. Moreover, it is unclear how those adapters are connected in the client.

In claim 14, it contains similar problems as in claims 1-3 above.

In claim 18, it is unclear what comprises those features of discovering, determining, encoding and transmitting? It is not understood how a signal-bearing media comprises those features.

In claim 22, it contains similar problem as in claim 18.

3. In response to the 35 U.S.C. § 112, second paragraph above, the applicant cited the portions of the specification (e.g., see the applicant's remark pages 8-10 and argued that when viewed in light of the supporting specification, in at least but not limited to the portions of the cited specification, claims 1-3, 7, 10, 14, 18, 22 and 26-27 are not indefinite, and comply with the requirements of 35 U.S.C. § 112, second paragraph.

In reply, Examiner respectfully disagrees because the language itself of the claims must particularly point out and distinctly claim the subject matter which the applicant regards as the present invention without limitations imported from the specification. See

In Re Lundberg, 113 USPQ 530 (CCPA 1957). **Thus, the 35 U.S.C. § 112, second paragraph is respectfully maintained and this rejection is Final.**

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

5. Claims 18-25 are still rejected under 35 U.S.C. § 101 because the claimed invention is directed to **non-statutory subject matter as being an intangible media (e.g., a signal-bearing media)** and an abstract idea. A signal-bearing media is incapable of being touched or perceived absent the tangible medium through which they are conveyed. Moreover, a medium containing machine-readable code would normally considered statutory subject matter. However, the instruction to provide signals is not tangibly embodied in a manner so as to be executable as the only hardware is in an intended use statement. Since it is the intent of the execution of a medium and not the medium itself that includes such hardware, thus this claim is not tangible.

6. In response to the above 35 U.S.C. § 101, applicant argues that:

- a) There is no requirement that statutory subject matter be tangible.
- b) The claimed invention is directed to statutory subject matter.
- c) The rejection fails to make a prima facie case to support the conclusion that the claims are directed to non-statutory subject matter.
- d) There are no clear statement of why the claimed invention is an abstract idea, other than that it is "intangible media".
- e) The rejection fails to point to specific disclosure portions that support a non-statutory conclusion.
- f) The non-statutory subject matter rejection is unsupported by the facts.

7. In reply to paragraph 6 above, Examiner respectfully disagrees because:

a) Yes, the claimed invention as a whole must produce a “useful, concrete and tangible result.” State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. MPEP 2106.

b) A **signal-bearing media** bearing instructions that **when** read and executed by a server is incapable of being touched or perceived absent the tangible medium through which they are conveyed. The instruction to provide signals is not tangibly embodied in a manner so as to be executable because of an intended use statement “when”. Since it is the intent of the execution of a medium and not the medium itself that includes hardware, **thus this claim is not tangible**. Therefore, the rejection absolutely makes a prima facie case to support the conclusion that the claims are directed to non-statutory subject matter. The rejection provides an explanation why the claimed invention is an abstract idea and non-statutory subject matter. And, the non-statutory subject matter rejection is unsupported by the facts.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-31 are still rejected under 35 U.S.C. § 103(a) as being unpatentable over Punj [U.S. Patent No. 5,289,579] in view of Gioquindo et al. [U.S. Patent No. 6,334,154].

8. Punj disclosed (e.g., see Figs. 1-6) the invention substantially as claimed. Taking claims 1, 5-7, 10, 18, 22 and 26-27 as exemplary claims, the reference discloses: a device (e.g., see col. 3, line 16); a name associated with the device (e.g., printers, discs, tape units, software systems, etc., col. 3, line 17); encoding the name into a second protocol format (e.g., see col. 2, lines 48-53).

While Punj disclosed that his data in a channel format are converted or encoded into a different format in order to allow the data to be transmitted over the network, Punj did not explicitly mention the use of the address resolution protocol for converting data format according to the client format in order to transmit the data between a client and a server. Such compatible feature of allowing data with different protocol formats to be transmitted among clients and a server would have been a desirable feature in the art, thus it would have been obvious to one of ordinary skill in the art to combine the teaching of Gioquindo's address resolution protocol into Punj's address conversion (e.g., see the abstract, Figs. 5-7, col. 6 (lines 1-34), col. 10 (lines 6-45)).

9. As to claims 3-4, 8-9, 11-17, 19-21, 23-25 and 28-31, Gioquindo disclosed a protocol format is Fibre Channel (e.g., see 22 of Fig. 1, col. 4 (line 3) and the second protocol is iSCSI over TCP/IP (e.g., see col. 3 (line 45) and col. 7 (line 47)).

10. In response to the above rejection, applicant substantially argued that the Office Action fails to state a prima facie case of obviousness with respect to claims 1-31 because the Office Action fails to show how to propose combination of Punj and Gioquindo et al. teaches or suggest all of the elements included in claims 1-31.

In reply, the Examiner respectfully disagrees because the Office Action clearly states what is the teaching of Punj; what is not teaching of Punj; what is the teaching of Gioquindo ; and what is a desirable feature that motivates one of ordinary skill in the art to combine the teaching of both references, etc. (See the previous Office Action as repeated in paragraphs 8-9). Thus, the Office Action clearly established a prima facie case of obviousness. Now, the burden is shifted to the applicant to rebut it with objective evidence of non-obviousness.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

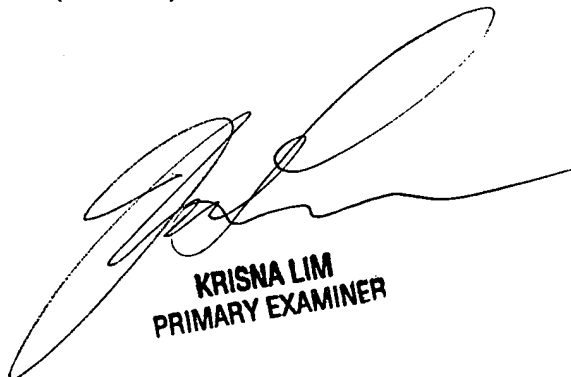
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956. The examiner can normally be reached on Monday to Wednesday and Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

May 11, 2006



KRISNA LIM
PRIMARY EXAMINER